Remarks

This response is filed within six months from October 3, 2005, and is filed with a request for extension of time. Claims 1-32 were pending in the application and the Examiner rejected claims 1-32. Claims 1-3, 5, 7, 16-18, 21, 22, 24, and 27-30 were rejected under 35 U.S.C. § 112 and 35 U.S.C. § 101. The Examiner also rejected claims 1-29, 31, and 32 under 35 U.S.C. § 103(a). Applicants amend independent claims 1, 17, 28, and 29 and dependent claims 2-3, 5, 7-8, 10, 12, 17-18, 21-24, and 28-30. Support for the amendments may be found in the originally filed specification, claims, and figures. No impermissible new matter has been added by these amendments. Reconsideration of the application is respectfully requested.

Claim Rejections -35 U.S.C. § 112

The Examiner rejected claims 1-3, 5, 7, 16-18, 21, 22 24, and 27-30 under 35 U.S. C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse.

The Examiner alleges that the recitation of the term "utilization quantity" is vague and indefinite. Applicants respectfully disagree with this assessment, however, in the interest of compact prosecution, Applicants have amended clams 1-3, 5, 7, 16-18, 21, 22, 24, and 27-30. Support for these amendments can be found in paragraphs 0059 and 0070-0072. Reconsideration of the claims is respectfully requested.

Claim Rejections – 35 U.S.C. Section 101

The Examiner also rejected claims 1-3, 5, 7, 16-18, 21, 22, 24, and 27-30 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. The Examiner alleges that the claims "only recite an abstract idea" and "do not apply, involve, use,

or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper." The Examiner does admit, however, that "the recited process produces a useful, concrete, and tangible result." Applicants respectfully traverse.

On November 22, 2005 (after the October 3, 2005 Office Action was mailed), the U.S.P.T.O. issued new "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" ("Guidelines"). The Guidelines stated that "United States patent law does not support the application of a 'technical aspect' or 'technological arts' requirement." Further, the Guidelines provided that "USPTO personnel should no longer rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter." Accordingly, Applicants believe that the section 101 rejection is no longer valid and that claims 1-3, 5, 7, 16-18, 21, 22, 24, and 27-30 are directed to statutory subject matter. Reconsideration of the claims is respectfully requested.

Claim Rejections – 35 U.S.C. Section 103

The Examiner rejected claims 1-29, 31, and 32 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Schoenbaum et al., U.S. Patent Pub. No. US2002/0147617 ("Schoenbaum") in view of Toan et al., U.S. Patent Pub. No. US2002/0095316 ("Toan"). (It is not clear whether claim 30 was rejected—see paragraph 6 of the Office Action). Applicants respectfully traverse.

Schoenbaum concerns a method and system for providing comparative cost information for health insurance plans. Schoenbaum provides estimates by comparing a user's household health care use with the heath care use of a reference population/household comparable to the user. (Schoenbaum, paragraph [0009]). Although Schoenbaum estimates the anticipated prescription costs for a user, Schoenbaum's method of doing so is inaccurate. The Examiner

alleges that Schoenbaum estimates costs by multiplying the sum of the unit cost of each product by the consumer's estimated utilization quantity of that product. However, the "units" of Schoenbaum are general "units of specific types of health care" such as "outpatient visits, emergency room visits, inpatient admissions, and prescriptions." (Schoenbaum, paragraph [0232]). Schoenbaum requires only that the user provide information on the total number of prescriptions that the user may need in the upcoming year and not on a drug-by-drug basis. (Schoenbaum, Table 4). Accordingly, Schoenbaum predicts the cost of a user's prescriptions by comparing the costs to a reference population's costs. (Schoenbaum, paragraphs [0229]-[0232]). For example, if the user's household (which includes a spouse and a child) needs six prescriptions over the course of a year, Schoenbaum would predict the user's prescription costs by referencing the prescription costs for another similar household with similar total prescription needs. (Schoenbaum, paragraphs [0229]-[0232]). Although the profiles of the user's household and the reference household may be similar, the types of prescriptions needed by each may differ vastly. For example, while the user may incur the low cost of an allergy prescription, the reference household may incur a much higher prescription cost for a cholesterol inhibitor.

The present invention, however, utilizes the unit cost of supplying **each** prescription drug under the plan and estimating the total prescription costs for a consumer based on the consumer's projected prescription drug utilization quantity for **each** prescription drug. Accordingly, the prescription cost estimates of the present invention are better because their calculation focuses on each type of prescription drug needed by each user. As a result, the present invention allows for better estimations of prescription drug costs.

Nor does Toan concern inputting the unit cost of supplying **each** prescription drug under different plans and estimating the total prescription costs for a consumer based on the

consumer's projected prescription drug utilization quantity for **each** prescription drug. Instead, Toan concerns a system and method for developing or modifying benefit plans by identifying and modifying specific plan options that maximize the perceived benefits derived from the plans. The information inputted in Toan is the cost of providing design options such as "monthly fixed contribution payment amount, periodic deductible amount, transactional copayment amount, coinsurance payment percentage, stop loss limitation, benefit cap limitation, pharmaceutical formulary coverage, pharmaceutical rebate applicability, retail network availability, mail delivery option, and generic pharmaceutical coverage." (Toan, paragraph [0038]). Thus, Toan concerns performing a cost/benefit analysis of health care plans using the costs of different health care coverage options. Because neither Schoenbaum nor Toan concerns estimating prescription drug costs on a per drug basis, no combination of these references can make obvious the claimed invention.

Schoenbaum in view of Toan does not disclose or suggest at least "inputting the unit cost of supplying each prescription drug provided under the plans; estimating the utilization quantity of each prescription drug for each consumer, thereby obtaining a projected prescription drug utilization quantity for each consumer; predicting the plan selected by each consumer; calculating the estimated cost by accumulating the costs of supplying each prescription drug to each consumer under the predicted plan, whereby the cost of supplying each consumer is the sum of the unit cost of each prescription drug multiplied by the consumer's projected prescription drug utilization quantity of that prescription drug, less any payments made by the consumer," as similarly recited in independent claim 1.

Nor does Schoenbaum in view of Toan disclose or suggest at least, "the processor programmed for estimating the utilization quantity of each prescription drug for each consumer,

thereby obtaining a projected prescription drug utilization quantity, predicting the plan selected by each consumer, and calculating the estimated cost by accumulating the costs of supplying each consumer, whereby the cost of supplying each consumer is the sum of the unit cost of each prescription drug multiplied by the consumer's projected prescription drug utilization quantity of that prescription drug, less any payments made by the consumer," as similarly recited in independent claim 16.

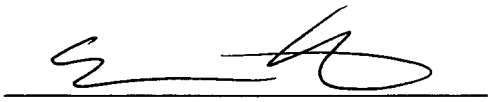
Further, Schoenbaum in view of Toan does not disclose or suggest at least, "inputting values corresponding to each plan design option in each plan; estimating the prescription drug utilization quantity of each prescription drug for the consumer, thereby obtaining the projected prescription drug utilization quantity; calculating the cost to the consumer for each plan by accumulating the transactional cost to the consumer for each prescription drug plus any periodic payments made by the consumer, wherein the transactional cost is the sum of the unit cost of each prescription drug under the respective plan multiplied by the consumer's projected prescription drug utilization quantity of that prescription drug," as similarly recited in independent claim 27.

Claims 2-15 variously depend from independent claim 1 and contain all the elements therein, claims 17-26 variously depend from independent claim 16 and contain all the elements therein, and claims 28-32 variously depend from independent claim 27 and contain all the elements therein. Therefore, Applicants respectfully submit that claims 2-15, 17-26, and 28-32 are differentiated from the cited art for at least for the same reasons as set forth above, in addition to their own respective features.

Applicants respectfully submit that the pending claims properly set forth that which Applicants regard as their invention and are allowable over the cited art. Accordingly,

Applicants respectfully request allowance of the pending claims. The Examiner is invited to telephone the undersigned at the Examiner's convenience, if that would help further prosecution of the subject Application.

Respectfully submitted,

By: 

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